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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/295,212 | 04/21/1999 | JOHN MELLARDO | MELLARDO-1 | 6931 |

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EXAMINER

MAYO III, WILLIAM H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2831

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/295,212

Applicant(s)

JOHN MELLARDO

Examiner

William H. Mayo III

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayh, III (Pat Num. 4,913,239) in view of Kramer et al (Pat Num. 4,483,395, herein referred to as Kramer). Bayh, III disclose an apparatus (i.e. cable arrestor, Figs 1-6) in combination with an energized-fluid conduit (Col. 1, lines 35-40) which houses a conduit (20-Fig 1) for transporting the energized fluid conduit (Col. 1, lines 35-40); a plurality of power conductors (88, 89, & 90-Fig 2C) confined within the conduit (20) and means (45-Fig 1) removable fixed to the conduit (20-Col 4, lines 1-4) for holding the power conductors (88, 89, & 90) in a spaced apart disposition across the conduit (20). With respect to claim 2, Bayh, III discloses that the means (45) comprises a means (i.e. platform-Fig 3A) for bridging across an intermediate portion of the conduit (20). With respect to claim 3, Bayh, III discloses that the bridging means comprises a platform (Fig 6) having conduit-engaging supports (Fig 3A, 37, 38, i.e. brackets). With respect to claim 4, Bayh, III discloses that the bridging means comprises an aperture platform (Fig 6), threaded pipe couplers (bottom of Fig 2A), which are in fixed alignment with the apertures (where the power conductors are located) and brackets (37, 38) for

Art Unit: 2831

removably fixing the platform (Fig 6) across the conduit (20, Col. 4, lines 1-4). With respect to claim 6, Bayh, III discloses that the power conductors (88, 89, & 90) terminate in a threaded pipe (Fig 3A) and the pipes are threaded engaged with pipe couplers (see Fig 3B). With respect to claim 7, Bayh, III discloses that there exist a means (128, 129, & 130) engaged with the power conductors (88, 89, & 90) for strain relieving the conductors (Col. 6, lines 52-57). With respect to claim 8, Bayh, III discloses that there exist a means (70, i.e. pump) in the form of control devices for energizing the fluid with the conduit (20) and wherein the cables (~~128, 129, & 130~~) are coupled to the control devices (Col. 4, lines 9-11). With respect to claim 9, Bayh, III discloses that the cable arrestor (Fig 1) further includes an axial pump (70) wherein the power conductors (88, 89, & 90) terminate in a threaded pipe fittings (Fig 3A) and the pump (70) has a thread pipe coupler (71) in which is threaded to receive a sheathing pipe fitting (see Fig 2F).

However, Bayh, III doesn't necessarily disclose that the means is removably fixed to the wall surface of the conduit (claim 1), nor the cable being jacketed with a sheath (claims 5-6 and 9).

Kramer (Pat Num. 4,483,395) teaches an wire guard (Figs 1-4) which may be used in a fluid conduit (i.e. well casing, Col. 1, lines 5-12) comprising a bridging means (10) having spaced apertures (30) for separating the conductors (17), that is attached to the wall surface within conduit (12) by rectangular tabs that project outward (Cols. 2-3, lines 67-68 & 1-5) for the purpose of attaching drop pipes, wires, and cables to a well

Art Unit: 2831

bore pump (15) and providing protection for the drop pipes, wires, and cables, from abrasion against the inner surface of the well casing (Col. 1, lines 33-36).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the bridging means of Bayh, III to comprise the bridging means as taught by Kramer because Kramer teaches that such a configuration provides protection from abrasion against the inner surfaces of the conduit (Col. 1, lines 33-36) and provides a simple and inexpensive construction that functions in a more efficient manner than any comparable device (Col 3, lines 60-65).

With respect to claims 5-6 and 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable of modified Bayh, III to be made with an outer protective sheath, since it is well known in the art of underwater cables that outer sheaths are utilized for protecting the inner conductors of the from external forces and corrosion.

Response to Arguments

3. Applicant's arguments filed April 4, 2002 have been fully considered but they are not persuasive. The applicant argues the following:

- A) Bayh in view of Kramer are not combinable in the manner as proposed by the examiner because there is no teaching or suggestion in these references to replace the electrical connector in Bayh with a wire guard as taught by Kramer.

Art Unit: 2831

- B) The proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified.

4. With respect to argument A, the examiner respectfully traverses. Firstly, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Bayh and Kramer teach connectors for a cable suspended in a wellbore and attached to a submersible well pump. Bayh and Kramer both teach connectors that anchor the cables suspended in the well (see Figs 1 in both references). However, Bayh doesn't teach the connector being removably fixed to the wall surface of the conduit. Kramer teaches that having such a connector configuration provides protection from abrasion against the inner surfaces of the conduit (Col. 1, lines 33-36) and provides a simple and inexpensive construction that functions in a more efficient manner than any comparable device (Col. 3, lines 60-65). Clearly, based on the teaching of Kramer, it would have been obvious to modify Bayh to comprise a connector being removably fixed to the wall surface of the conduit, in order to provide the conductors of Bayh with protection from abrasion against the inner surfaces of the conduit, wherein the configuration as taught by Kramer's simple and inexpensive and functions in a more efficient manner than any comparable device, such as Bayh's connector. Therefore, there does exist a teaching and

Art Unit: 2831

motivation for modifying Bayh's connector as taught by Krammer. In view of the above comments, the examiner willfully submits that the 35 USC 103 rejection is proper and just.

With respect to argument B, the examiner respectfully traverses. Firstly, the examiner respectfully submits that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, as disclosed above, Kramer clearly teaches that having such a connector configuration provides protection from abrasion against the inner surfaces of the conduit (Col. 1, lines 33-36) and provides a simple and inexpensive construction that functions in a more efficient manner than any comparable device (Col 3, lines 60-65) and based on these teachings^{ings} of Krammer, it would have been obvious to modify Bayh to comprise a connector being removably fixed to the wall surface of the conduit, in order to provide the conductors of Bayh with protection from abrasion against the inner surfaces of the conduit, wherein the configuration as taught by Kramer's simple and inexpensive and functions in a more efficient manner than any comparable device, such as Bayh's connector.

DR 5/17/02

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Communication

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (703) 306-9061. The examiner can normally be reached on M-F 8:30 a. m. -6:00 p.m. (alternating Friday's off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-1341 for After Final communications.

Application/Control Number: ***

Page 8

Art Unit: 2831

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

WHM III
May 16, 2002

Dean A. Reichard 5/17/02

DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
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